

REMARKS

ELECTION/RESTRICTIONS

The applicant makes a provisional election with traverse to prosecute Group I, claims 1-25. Applicant has cancelled claims 26-45 without prejudice and reserves the right to file divisional applications to prosecute these claims further. Applicant is aware that upon the cancellation claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. However, no amendment of inventorship is necessary, as all of the named inventors have contributed to currently pending claims 1-25. Applicant is further aware of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. However, the subject matter of claims 1-25 was commonly owned at the time the inventions covered in the application.

DRAWINGS

The specification has been amended in order to properly annotate reference numerals 32 (primary recharging coil), 82 (proximal side), and 84 (distal side) in the description. The amendments above to the specification and drawings overcome the examiner's objection to the drawings. Further, applicant submits that no new matter has been inserted into the application as all above mentioned reference numerals were already existent in the application as filed.

CLAIM REJECTIONS – 35 USC § 112

With reference to amended claims 1 and 23, the term “with” has been replaced with the term “having an” to more clearly state the claim. The examiner stated that the term “a proximal face” is vague since it is unclear what direction is “proximal”. With reference to the specification page 6, lines 14-19 and with reference to FIG. 4a, it is clear that the term “proximal” references the direction toward the patient’s skin, therefore the term “a proximal face” is positively recited. The examiner states that “an electrical feedthrough” makes the claim incomplete since there is no connection of the feedthrough to any other element. However, with reference to page 5, line 19 to page 6, line 13 and with reference to FIG. 4a it is shown that the housing has “an electrical feedthrough” and therefore is a positive recitation of the housing structure. The examiner states that “a distal side” is vague since there is no set direction in the system. However, once again with reference to page 6 lines 14-19 and with reference to FIG. 4a it is stated that the distal side is toward the patient’s internal organs. Therefore, the term “a distal side” is not vague at all. Finally, the term “the receiving recharging coil” has been amended to state “the recharging coil” to provide proper antecedent basis.

The examiner rejected claim 2 under §112 stating that “a primary recharging coil” is inferentially included and has not been positively recited. However, the applicant is not claiming the primary coil and, therefore, asks that the rejection be withdrawn.

The examiner rejected claim 3 under §112 stating that “is improved” is vague since it is unknown what element is doing the “improving”. Claim 3 has been amended to clearly show what element is doing the improving.

With respect to claims 4, 24 and 25, these claims have also been amended to clearly state what element is doing the improving. Claim 5, however, clearly references back to claim 1 to show what element is improving the recharging efficiency. Further, claim 5 has been amended to clearly show what element is providing flux lines.

Claims 6-8 have been amended to clearly show what element is reducing eddy currents and temperature. Further, claims 6 and 7 have been amended to positively recite the reduced eddy currents and recharging. Finally, claim 8 has been amended to clearly recite the implantable medical device temperature rise during recharging is less than two degrees Celsius.

Claim 9 has been amended to clearly show that it depends from claim 1. Further with reference to claim 10 and page 8 of the specification, lines 5-10, the term “high” is clearly described.

With reference to claim 12, eddy current flow is not being claimed and, therefore, does not need to be positively recited.

Claims 14, 15, 16 and 17 have been amended to positively recite elements and correct for any lack of antecedent basis. Further, claim 18 has been amended to overcome the examiner’s rejection.

CLAIM REJECTIONS – 35 USC § 102/103

Claim 1 was rejected under 35 U.S.C. §102(b) as anticipated by, or “in the alternative, under 35 U.S.C. §103(a) is obvious over Kelly (U.S. Patent 4,041,955). Claim 1 as amended recites “a generally planar magnetic shield placed on the distal side of the recharging coil to improve recharging efficiency, the shield being generally perpendicular to an axis of the

recharging coil and the shield located between the recharging coil and the electronics.” By contrast, the ferrite slabs 32 and 33 having a high magnetic permeability as taught by Kelly are parallel to the axis of pick up coil 21. Support for the above noted recitation is found at column 5, lines 55-60 and FIGS. 2 and 3 in the Kelly specification. Claim 1 as amended is, therefore, patentably distinguished from Kelly.

Claims 2-8, 10, 11, 13, 14, and 17-22 all depend from allowable claim 1. Therefore, claims 2-8, 10, 11, 13, 14 and 17-22 are patentably distinguished from Kelly.

Claim 23 was rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Kelly (U.S. Patent No. 4,041,955). Claim 23 as amended recites “means for improving recharging efficiency placed on a distal side of the secondary recharging coil, the means having eddy cuts to reduce eddy current flow and the means located between the recharging coil and the electronics.” By contrast, the ferrite slabs 32 and 33 of high magnetic permeability as taught by Kelly do not have any eddy cuts in which to reduce eddy current flow. Support for the above noted recitation can be found at column 5, lines 55-60 and FIGS. 2 and 3 in the Kelly specification. Claim 23 as amended is therefore felt to distinguish patentability from Kelly.

Claims 24 and 25 depend from allowable claim 23. Therefore claims 24 and 25 are patentably distinguished from Kelly. This argument also applies to the 103(a) rejection and therefore Claims 1-8, 10, 11, 13, 14, and 17-25 are not obvious in view of Kelly.

Claim 1 was rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Zarinetchi (U.S. Patent No. 6,324,431). Claim 1 as amended recites a generally planar magnetic shield placed on the distal side of the recharging

coil to improve recharging efficiency, the shield being generally perpendicular to an axis of the recharging coil and the shield located between the recharging coil and the electronics. By contrast, the cage 22 formed of a high magnetic permeability material as taught by Zarinetchi is not located between secondary coil 16 and electronics 18. Support for the above noted recitation can be found in column 4, lines 42-65 and FIGS. 3 and 5 in the Zarinetchi specification. Claim 1 as amended is therefore felt to be patentably distinguished from Zarinetchi.

Claims 2-8, 10, 11, 13, 14, and 17-22 depend from allowable claim 1. Therefore claims 2-8, 10, 11, 13, 14, and 17-22 are patentably distinguished from Zarinetchi.

Claim 23 was rejected under 35 U.S.C. §102(e) as anticipated by, in the alternative, 35 U.S.C. §103(a) as obvious over Zarinetchi (U.S. Patent No. 6,324,431). Claim 23 as amended recites “means for improving recharging efficiency placed on the distal side of said secondary recharging coil, the means having eddy cuts to reduce eddy current flow and the means located between the recharging coil and the electronics.” By contrast the cage 22 formed of high magnetic permeability material as disclosed by Zarinetchi does not have eddy cuts in which to reduce the eddy current flow. Support for the above noted recitation can be found in column 4, line 61 to column 5, line 43 in the Zarinetchi specification. Claim 23 as amended is therefore patentably distinguished from Zarinetchi.

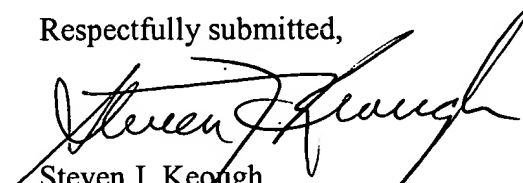
Claims 24 and 25 depend from allowable claim 23. Therefore claims 24 and 25 are patentably distinguished from Zarinetchi. This argument also applies to the 103(a) rejection and therefore Claims 1-8, 10, 11, 13, 14, and 17-25 are not obvious in view of Zarinetchi.

Applicant reserves the right to swear behind the 102(e) Zarinetchi reference.

In view of the foregoing, it is submitted that claims 1-25 are in condition for allowance.
Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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